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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,189	06/05/2006	Rodric Lindsay Fooks	DUMME66.001APC	5311
20995 7590 10/07/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER KWIKTNSKL RYAND				
ART UNIT 3635		PAPER NUMBER		
NOTIFICATION DATE 10/07/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,189

Applicant(s)

FOOKS, RODRIC LINDSAY

Examiner

RYAN D. KWIECINSKI

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 6/5/2006
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "38" and "39" have both been used to designate the sprung retainers.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

- 1) reference character "41" has been used to designate both the top ledge and the recess grooves.
- 2) reference character "145" has been used to designate both the guide and the horizontal member in Fig.5.
- 3) reference character "260" has been used to designate both the extruded element and the fan assembly.
- 4) reference character "258" has been used to designate both the rod and the connection assembly.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because **they do not include the following reference sign(s) mentioned in the description:**

- 1) **16A**
- 2) **52**

- 3) 51
- 4) 50
- 5) 55
- 6) 56
- 7) 122
- 8) 143
- 9) 146
- 10) 300
- 11) 302
- 12) 303

The drawings are objected to as failing to comply with 37 CFR 1.84(h)(2) because **they do not include separate labels for the view and the enlarged view in Figure 8 and Fig.12.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

- 1) **Page 7, line 24**, "figure 6" should be –figure 5–.
- 2) **Page 9, lines 19-20**, the specification refers to the inset of Figure 2, but there is not inset of Figure 2 in the drawings.
- 3) **Page 10, line 5**, the specification refers to Figure 1A, but there is not Figure 1A in the drawings.
- 4) **Page 13, lines 12-13**, the specification refers to the inset of Figure 11, but there is not inset of Figure 11 in the drawings.
- 5) **Page 13, line 15**, "minimise" should be –minimize--.

Appropriate correction is required.

Claim Objections

Claims 3 and 6 are objected to because of the following informalities:

Claim 3 recites the limitation "**the batten timbers**" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "**the two horizontal sides**" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7-9, and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "**the two sloping sides of said skylight**" in line 2. There is insufficient antecedent basis for this limitation in the claim. The recitation renders the claim vague, indefinite, and confusing because the claims do not recite or describe the skylight being sloped in the prior claims. It is not clear if the skylight is sloped, if the roof is sloped, etc.

Claim 7 recites the limitation "**the extruded elements**" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether the claimed "extruded elements" are referring back to the "extruded sections" per claim 2 or if the "extruded elements" are a different structural member.

Claim 9 recites the limitation "**said extruded members**" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether the

claimed "extruded members" are referring back to the "extruded sections" per claim 2 or if the "extruded members" are a different structural member.

Claim 16 recites the limitation "**said internal sash frame**" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "**said clamping members**" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "**said perimeter seal**" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "**said sprung retainer elements**" in line 3. There is insufficient antecedent basis for this limitation in the claim.

THE CLAIMS HAVE BEEN EXAMINED AS BEST UNDERSTOOD.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,928,445 to Sampson et al.

The term “extruded” throughout the claims is a product by process limitation and does not further limit the structure in which it describes.

Claim 1:

A skylight system including a prefabricated mounting frame (14, Fig.2) and a prefabricated hood assembly (22, Fig.2), adapted to assemble together to form a skylight.

Claim 2:

The skylight system of claim 1 wherein, said prefabricated mounting frame comprises a rectangular arrangement of sections (14) to form a rectangular support structure (Fig.1).

Claim 3:

The skylight system of claim 2 wherein, said sections are provided with bottom flange portions (bottom of 14, bottom of hollow portion 26) adapted to seat on the batten timbers (70) of a sloping roof.

Claim 4:

The skylight system of claim 2 wherein, said sections are provided with a pair of closely spaced projecting flanges (flanges holding 11 and flanges holding 28) adapted to accept and retain pre- assembled flashing elements attached to said sections.

Claim 9:

The skylight system of claim 3 wherein said members are provided with a horizontal ledge (top ledge 62) extending outwardly from said members, said horizontal ledge adapted to support a sealing strip (64), said sealing strip forming a perimeter seal around the top of said prefabricated mounting frame.

Claim 10:

The skylight system of claim 1 wherein, said prefabricated hood assembly includes perimeter capping (22), glass layers (16, 18), internal sash frame (20), seal elements (44) and clamping members (25).

Claim 11:

The skylight system of claim 10 wherein, said perimeter capping is fabricated from elements adapted to provide framing of said glass layers (22) and support for said clamping members (25).

Claim 13:

The skylight system of claim 10 wherein, said seal elements (44) provide support for said glass layers (18).

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2,968,263 to Huston et al.

Claim 1:

A skylight system including a prefabricated mounting frame (2, Fig.1) and a prefabricated hood assembly (23, Fig.1), adapted to assemble together to form a skylight.

Claim 2:

The skylight system of claim 1 wherein, said prefabricated mounting frame comprises a rectangular arrangement of sections (11) to form a rectangular support structure (straight edges shown in Figure 1 and 2).

Claim 7:

The skylight system of claim 2 wherein, said prefabricated mounting frame is provided with sprung retainer elements (15) attached to each of the elements forming the sides of said rectangular support structure.

Claims 1, 10-12, 14, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,355,644 to Guhl et al.

Claim 1:

A skylight system including a prefabricated mounting frame (12, 13, Fig.2) and a prefabricated hood assembly (30), adapted to assemble together to form a skylight.

Claim 10:

The skylight system of claim 1 wherein, said prefabricated hood assembly includes perimeter capping (30), glass layers (16), internal sash frame (11), seal elements (24 and the seal element beneath the window assembly, Fig.2) and clamping members (26).

Claim 11:

The skylight system of claim 10 wherein, said perimeter capping (30) is fabricated from elements adapted to provide framing of said glass layers (Fig.2) and support for said clamping members (26).

Claim 12:

The skylight system of claim 11 wherein, said internal sash frame (11) is retained within said perimeter capping by said clamping members (26), said clamping members provided with a clamping ledge (25a, Fig.2) adapted to engage in grooves (groove in which 25a rests on. Fig.2) provided in the outer faces of said internal sash frame.

Claim 14:

The skylight system of Claim 10, said glass layers are clamped between said perimeter capping (30), said seal elements (24) and said internal sash frame (11) by said clamping members (clamping member 26 holds all the elements together).

Claim 16:

The skylight system of Claim 1 wherein, said prefabricated hood assembly is adapted for assembly with said prefabricated mounting frame (Fig.2) so that said internal sash frame locates within said prefabricated mounting frame (portions of the internal sash frame are within the perimeter of the mounting frame); said clamping members seating on said perimeter seal (clamping members along with the internal sash frame are seated on the sealing curve of 13, Fig.2).

Claim 17:

The skylight system of claim 16 wherein, said prefabricated hood assembly is retained in sealing engagement with said prefabricated mounting frame by means of said sprung retainer elements (14h) engaging in recesses groove in the bottom side surface of 11) provided in the outer surfaces of said internal sash frame.

Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,553,425 to Sampson et al.

Claim 1:

A skylight system including a prefabricated mounting frame (14, Fig.3) and a prefabricated hood assembly (32), adapted to assemble together to form a skylight.

Claim 2:

The skylight system of claim 1 wherein, said prefabricated mounting frame comprises a rectangular arrangement of sections to form a rectangular support structure (Fig.1).

Claim 4:

The skylight system of claim 2 wherein, said sections are provided with a pair of closely spaced projecting flanges (42, 44) adapted to accept and retain pre- assembled flashing elements (48) attached to said sections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2,968,263 to Huston et al.

Claim 8:

Huston et al. disclose the skylight system of claim 7 wherein, said sprung retainer elements are in the form of bent metal strips (15) with the ends of said strips forming an angle with said sides of said rectangular support structure (strips are bent inwardly), such that said lower ends deflect inwardly from said sides.

Huston et al. do not disclose the lower ends of the strips are bent in but do in fact disclose the ends of the strips are bent in.

It would have been obvious to have arranged the spring retainers in any configuration as long as the sprung retainers secure the mounting frame the structure of the roof. Turning the retainer 180 degrees will not affect the securing capabilities of the retainer.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,355,644 to Guhl et al.

Claim 15:

The skylight system of claim 14 wherein, said clamping members are fastened to said perimeter capping by self tapping screws.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,553,425 to Sampson et al.

Claims 5 and 6:

Sampson et al. disclose the skylight system of claim 4 wherein, said flashing elements along sides of said skylight, comprise metal strips (48), but does not specifically disclose wherein the metal strips are formed from roll-formed metal or from malleable metal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the flashing members from the desired metal material for the use of each flashing member. If the flashing is being used in a location that needs durability and strength then a roll-formed piece of metal should be used. If the flashing is being used in a location where the metal may need to be bent or nested with other materials then a malleable piece of metal flashing may be used. It is an obvious engineering design choice to construct the flashing out of a metal material with the structural properties necessary for the installation of the flashing.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,355,644 to Guhl et al. in view of US 5,148,643 to Sampson et al.

Claim 18:

Guhl et al. disclose the skylight system of claim 15, Guhl et al. also disclose a hinge but do not specifically disclose wherein, said prefabricated mounting frame is provided with an hinge section; said hinge section adapted to be a clip-on attachment to one of said sections of said prefabricated mounting frame.

Sampson et al. disclose a clip on hinge section provided for the skylight assembly (72A, 72B).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the mounting frame with a clip on hinge section so the skylight can functionally open and close and also so the hood assembly can be removed for repairs, cleaning etc. The clip on hinge will reduce the difficulty of installation as well as reduce the time spent removing the hood assembly if necessary.

Claim 19:

Guhl et al. in view of Sampson et al. disclose the skylight system of claim 18 Sampson et al. disclose wherein, said hinge section includes an lobe element (72B), said lobe element being of substantially circular section and further including a convex arcuate guide segment (the outer surface of 72B) concentric with said lobe element.

Claim 20:

Guhl et al. in view of Sampson et al. disclose the skylight system of claim 19 wherein, at least one of said elements of said perimeter capping of said prefabricated hood assembly includes an hinge element of partially cylindrical form (72A) and a concave arcuate guide segment (inner surface of said cylindrical form) concentric with said hinge element, said hinge element and said concave arcuate guide segment adapted to mate with said lobe element (72B) and said convex arcuate guide segment so as to allow rotation of said prefabricated hood assembly about said lobe element

when one of said hinge elements of said perimeter capping is assembled with said lobe element.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN D. KWIECINSKI whose telephone number is (571)272-5160. The examiner can normally be reached on Monday - Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

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